

REMARKS/ ARGUMENTS

The final Office Action of March 18, 2008, has been reviewed and these remarks are responsive thereto. Claims 1-4, 10-13, 19-22, and 25-38 remain pending in this application. Reconsideration and allowance of the instant application are respectfully requested.

Statement of Common Ownership

The present application and U.S. Patent Appl. Pub. No. 2002/0085090 (Kamen) were, at the time the invention was made, owned by, or subject to an obligation of assignment to the same entity (iSurfTV Corporation). Accordingly, any reliance on Kamen as part of a rejection under 35 U.S.C. §103(a) is improper.

Rejections Under 35 U.S.C. § 103

Claims 1-4, 10-13, 19-22 and 25-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Appl. Pub. No. 2001/0005905 (Saib), in view of U.S. Patent No. 7,324,168 (Griesau). Claims 28, 33, and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Saib, in view of U.S. Patent No. 2002/0085090 (Kamen). Claims 29, 30, 34, and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Saib, in view of Kamen, and further in view of Griesau. Claims 31 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Saib, in view of Kamen, and further in view of U.S. Patent No. 5,844,620 (Coleman). Claims 32 and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Saib, in view of Kamen, and further in view of U.S. Patent No. 6,757,906 (Look).

Applicants respectfully traverse these rejections.

Disqualifying Griesau

Claims 1-4, 10-13, 19-22 and 25-27 stand rejected under 35 U.S.C. § 103(a) over Saib in view of Griesau. Applicants respectfully submit that Griesau is not prior art to the present application, and that the rejections based on Griesau cannot stand.

The Griesau reference has a filing date of October 30, 2002, which is later than the priority date of the present application. Thus, the Griesau reference is not, by itself, available for consideration under 35 USC § 102(c).

Griesau does claim priority to prior non-provisional application serial no. 09/419,605 (the '605 application), filed October 18, 1999, now U.S. Patent No. 6,507,306. However,

the Office Action makes no reference to the purported disclosure of the earlier-filed '605 application. The Griesau reference is properly cited against the present application only if "the earlier-filed application properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. § 112, first paragraph." (M.P.E.P. 2136.03 (IV)). Applicants respectfully submit that it is incumbent upon the Office to find support for the rejection in the earlier '605 application in order to attempt to enter a rejection under 35 U.S.C. §103(a). Because the Office Action does not rely on the disclosure of the '605 application, nor even refer to this earlier-filed application, the rejection is improper.

Applicants further submit that the earlier-filed '605 application does not support a rejection under 35 U.S.C. §103(a). The Office Action alleges on page 3 that Griesau teaches a button in a universal remote control that can be programmed for more than one function at col. 2, lines 16-19 and 54-58, and at col. 2, line 66 to col. 3, line 3. However, none of the relied-upon portions of Griesau are present in the '605 application, nor does any other portion of the '605 application teach or suggest a button that can be programmed for more than one function.

Accordingly, Griesau is unavailable as a prior art reference in the rejection of claims 1-4, 10-13, 19-22 and 25-27 under 35 U.S.C. §103(a). Applicants respectfully request that these rejections be reconsidered and withdrawn.

Unavailability of Kamen

Claims 28-28 stand rejected under 35 U.S.C. § 103(a) over various combinations involving the Kamen reference. The above Statement of Common Ownership removes Kamen as an applicable reference for a rejection under 35 U.S.C. §103(a), and these rejections are therefore respectfully traversed for at least this reason.

Applicants reserve the right to attack the alleged teachings of the above-cited references, as well as the various combinations of these references. Applicants do not do so at this time because Applicants believe that prosecution is most expeditiously advanced by the above arguments.

CONCLUSION

Based on the foregoing, Applicants respectfully submit that the application is in condition for allowance and a Notice to that effect is earnestly solicited. Should the Examiner believe that anything further is desirable in order to place the application in even better form for allowance, the Examiner is respectfully urged to contact Applicants' undersigned representative at the below-listed number.

Respectfully submitted,
BANNER & WITCOFF, LTD.

Dated this 18th day of June, 2008

By: /Brian J. Brisnehan/
Brian J. Brisnehan, Registration No. 60,462
1100 13th St., N.W.
Washington, D.C. 20005-4051
Tel: (202) 824-3000
Fax: (202) 824-3001